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# D E C I S I O N
## of 19 February 2002

**Case Number:** T 0852/99 - 3.5.1

**Application Number:** 91121529.1

**Publication Number:** 0502255

**IPC:** H04N 5/44

**Language of the proceedings:** EN

**Title of invention:**
Improved television signal selection device

**Patentee:**
EDICO S.r.l.

**Opponent:**
Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

**Headword:**
Signal selection device/EDICO

**Relevant legal provisions:**
EPC Art. 56, 114(2)

**Keyword:**
"Inventive step (yes)"
"Late-filed grounds"

**Decisions cited:**
G 0009/91, G 0010/91

**Catchword:**
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Beschwerdekammern | Boards of Appeal | Chambres de recours

**Case Number:** T 0852/99 - 3.5.1

# D E C I S I O N
## of the Technical Board of Appeal 3.5.1
## of 19 February 2002

**Appellant:** (Opponent)
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**Representative:**
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**Decision under appeal:** **Interlocutory decision of the Opposition Division of the European Patent Office posted 28 July 1999 concerning maintenance of the European Patent No. 0 502 255 in amended form.**

**Composition of the Board:**

**Chairman:** S. V. Steinbrener
**Members:** A. S. Clelland
P. Muehlens

## Summary of Facts and Submissions

I. This appeal is against the interlocutory decision of the Opposition Division finding European patent No. 0 502 255 as amended before the first instance to meet the requirements of the convention. The opposition proceedings were primarily concerned with the issue of inventive step, Article 100(a) EPC,the opponent relying *inter alia* on the following document:

D1: DE-A-29 50 432

In the course of the opposition proceedings the opponent raised additional issues under Articles 100(b) (insufficient disclosure) and Article 100(c) EPC (added subject-matter), and filed an additional document in support of the objection of lack of inventive step:

D5: DE-A-38 32 887.

II. The Opposition Division held that the grounds of opposition under Articles 100(b) and 100(c) were late-filed and were not *prima facie* relevant in a manner prejudicial to maintenance of the patent; these grounds were therefore held to be inadmissible. For similar reasons document D5 was not admitted to the proceedings. As regards Article 100(a) EPC, the Opposition Division held that the subject-matter of claim 1 involved an inventive step.

III. The appellant (opponent) lodged an appeal against the Opposition Division's decision and paid the prescribed fee; it was requested that the decision under appeal be set aside and the patent revoked. An auxiliary request was made for oral proceedings. A statement of grounds

of appeal was subsequently filed, maintaining the objections of lack of inventive step on the basis of D1 and D5. The objections of insufficiency and added subject-matter, which the Opposition Division had refused to admit to the proceedings, were also maintained. The respondent (patentee) in reply stated that no objection was raised to the admission of D5 to the proceedings and argued that the subject-matter of claim 1 was novel and inventive having regard to the disclosure of either D1 or D5. It was requested that the appeal be dismissed; an auxiliary request was made for oral proceedings.

IV. Oral proceedings were appointed for the 19 February 2002. Prior to the oral proceedings and following a communication from the Board the respondent filed a revised claim 1 to replace that on file and intimated that auxiliary requests based on a combination of the main claim and various subordinate claims might be presented at the oral proceedings.

V. Claim 1 reads as follows:

"Television signal receiver:

- comprising means (R, W, 20) for entering data specifying an automatic programme change,

- means (17, 21, 22) for selecting a television channel other than a tuned-in television channel in accordance with the entered data,

- means (19) for providing an identifying signal identifying a programme or a change of a programme transmitted on the selected channel,

- means (17) for detecting a change of the programme transmitted on the selected channel in response to the identifying signal, and

- tuning means (7, 17) for tuning the receiver automatically into the selected channel to perform the automatic programme change,

wherein

- the automatic programme change is specified by data identifying only the selected channel and entered while said tuned-in television channel is tuned in, and

- the tuning means (7, 17) tune into the selected channel solely in response to the first change of the programme detected by the detecting means (17) subsequent to the entering of said data."

VI. In the course of the oral proceedings a revised set of appendant claims was presented. At the end of the oral proceedings the chairman announced the decision of the Board.

## Reasons for the Decision

1. The appeal complies with the provisions of the European Patent Convention and is admissible.

2. *Late-filed grounds of opposition*

2.1 The originally filed notice of opposition referred to "lack of patentability in accordance with Article 100

EPC in connection with Articles 52 to 57 EPC" (Board's translation), but the only grounds of opposition made explicit were based on the prior art and were apparently lack of novelty with respect to the disclosure of D2 (not raised in the present proceedings) and lack of an inventive step with respect to the disclosure of D1. Approximately one year after the end of the 9-month opposition period the opponent then raised further objections based on Articles 100(b) EPC and 100(c) EPC.

2.2 In accordance with the Enlarged Board's decisions G 9/91 and G 10/91 (OJ EPO 1993, 408 and 420) the first instance has a discretion to admit late-filed grounds of opposition where, *prima facie,* there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent. The Board has accordingly considered whether the Opposition Division exercised its discretion correctly. The Board would observe that the Enlarged Board also went on to state that in the case of appeal proceedings the inclusion of late-filed grounds depended on the consent of the patent proprietor; in the present case, the proprietor in the course of the oral proceedings refused to consent to the introduction of new grounds.

2.3 The Board considers that the objections raised under Articles 100(b) and 100(c) are in essence objections to the clarity of claim 1 as granted rather than issues of insufficiency and added subject-matter which would prejudice the maintenance of the patent. In the circumstances, it is clear that the opposition division exercised its discretion correctly in holding these objections inadmissible, so that these grounds have not

been considered in the present proceedings.

3. *Technical background to the patent*

The patent is concerned with a very common situation which arises when viewing television, namely the desire not to miss a start of a specific programme on one channel when watching a different programme on another channel. One solution to this problem is the so-called "picture in picture" system in which a television has two tuners and a memory, the second programme being shown in a window within the first programme; the patent (see column 1, lines 20 to 31) describes such a system as rather expensive in view of the extra hardware required and disturbing the viewing of the main programme because of the presence of the window. This problem is in accordance with the patent solved by providing extra hardware so that two channels can be received simultaneously, one channel being viewed and the other channel monitored for detection of a signal representing a desired programme to be viewed; on detection of said signal the receiver switches channels to the monitored channel. In the preferred embodiment the VPS signal, normally used to enable accurate video recording, is used to identify a specific programme on a monitored channel. In the simplest version it is assumed that the next programme to be viewed on the monitored channel is the desired programme, so that any change in the programme signal is taken to mean that the desired programme is now being displayed and the receiver is switched accordingly. By providing an extra button on the remote control, which is pressed when a specific channel is being viewed, any other channel can thereafter be viewed and a change in programme content

of the first channel will result that channel again being displayed.

4. *Inventive step*

4.1 The Board considers that the features added to claim 1 in the present proceedings are clear and were originally disclosed. The only issue to be decided is whether the subject-matter of claim 1 involves an inventive step having regard to the disclosure of each of documents D1 and D5.

4.2 Considering document D1 first, this discloses a precursor to the well-known VPS system in which a programme information code is stored in the transmitted signal so that a suitable decoder can detect when a desired programme is being transmitted and cause a video recorder to start recording. In D1, as in VPS, the code is included in the vertical blanking interval. The document refers to a "television signal receiving device" and the preferred uses appear to be video recording of a specific programme or programmes, and authorizing reception of a specific class of programme on a television receiver, for example films suitable for children of a certain age. D1 does not disclose a working embodiment but discusses in general terms how such a device might be used. In accordance with page 7, lines 5 to 14 the device may be an add-on to an existing television or VCR, whilst page 7, line 30 to page 8, line 4 suggests that the device can be incorporated in a new receiver and can operate whilst the receiver itself is in stand-by mode.

4.3. The appellant drew attention to page 4, lines 14 to 17 of D1 in which it is stated that in addition to

switching a receiver on and off it is also possible for the device to operate the receiver in other ways, for example by switching to an alternative programme or rewinding a VCR in order to restart after a technical fault. The appellant argued that if the D1 device could be used to switch between programmes in response to a code then virtually all the features of claim 1 were known from D1.

4.4 Considering revised claim 1 in the light of the disclosure of D1, a television receiver is claimed which has means for entering data specifying an automatic programme change; the Board notes that although the word "programme" is used in the claim, the context makes clear that what is meant is that the channel is changed. The claim goes on to specify means for selecting a television channel other than a tuned-in television channel in accordance with entered data, and means for providing an identifying signal identifying a programme or a change of a programme transmitted on the selected channel. The Board notes that although in D1 the passage cited at page 4, lines 14 to 17 refers to the switching of the receiver from one channel to another, there is no suggestion that the switching signal is transmitted on the selected channel rather than the viewed channel. The appellant argued that the use of the device as an add-on to an existing television or VCR showed that this could in fact be done, however, the document nowhere suggests this; the passage bridging pages 7 and 8 makes clear that in a newer receiver in which the device is integrated the main receiver part will be on stand-by until switch-on by the device. The preceding passage on page 7, dealing with an add-on device to be used with an existing

television or VCR, makes clear that the controlled receiver is off until the device turns it on. At no time are two tuners, monitoring different channels, in operation.

4.5 Since the essence of the claimed invention is that whilst one channel is being watched another channel is monitored until a desired programme is transmitted and thereafter the latter channel is displayed, the Board does not consider that the skilled person would be led by D1 to such an arrangement. The obvious manner of operation in D1 would be to send a signal encoded in the displayed channel to cause the device to switch to another channel. D1 would not lead the skilled person to provide means for detecting a change of the programme transmitted on the selected, ie the non-displayed, channel and to cause an automatic channel change when the signal identifying a change of a programme is received.

4.6 The Board accordingly concludes that the subject-matter of claim 1 involves an inventive step having regard to the disclosure of document D1.

4.7 Turning now to document D5, this relates to a non-standard TV system in which, in one embodiment, four pairs of pilot tones are available for transmission with each channel in order to indicate four types of programme content. The user can set the receiver so as to indicate a desired programme content in descending order of choice, so that when the receiver is switched on it scans for the first-choice content and, if this is not available, the second-choice, and so on down (see in particular column 3, line 27 to column 4, line 31). It was argued by the appellant that such a

system in effect carried out the same function as claimed in the patent, in that when a second-choice programme was being viewed and a first-choice programme became available, the receiver would switch automatically to the first-choice program.

4.8 The Board notes that in D5 the only criterion is content. If one particular content is selected, for example news, the receiver will hop between channels in dependence on where a news bulletin is being shown, regardless of the viewer's wishes. D5 does not disclose how a viewer can select a specific programme on a specific channel. Claim 1 however requires means for selecting a television channel other than a tuned-in television channel, and means for entering data specifying an automatic programme change - so as to switch to the selected channel - which takes place in response to a change in programme rather than a programme priority. Thus, the skilled person would not be led by the disclosure of D5 to the receiver of claim 1.

4.9 The Board therefore concludes that the subject-matter of claim 1 involves an inventive step having regard to the disclosure of D5.

4.10 Nor does it appear to the Board that there is any plausible combination of D1 and D5, or any disclosure in any other document known to the Board, which would lead the skilled person in the direction of the claimed invention.

## Order

**For these reasons it is decided that:**

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent on the basis of:

   claim 1 filed with letter dated 18 January 2002,

   claims 2 to 18 filed in the oral proceedings,

   description and drawings as set out in the decision under appeal.

The Registrar: The Chairman:

M. Kiehl S. V. Steinbrener